

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 15

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SEP 07 2004

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHASE A. HAFNER, WILLIAM R. MUTSCHLER,
BRIAN J. WALKER and DAVID S. JOYCE

Appeal No. 2003-1048
Application 09/421,038

ON BRIEF

Before HAIRSTON, JERRY SMITH and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-19, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for managing information and rendering discounts in a billing system.

Representative claim 1 is reproduced as follows:

1. A method for managing information and rendering discounts in a billing system, the method comprising:

receiving a customer record including data;

establishing a rule-based accumulation engine;

processing the record with the accumulation engine to accumulate the data in a plurality of predetermined target accumulators;

establishing a rule-based discount engine; and

processing the plurality of target accumulators with the discount engine to render discounts applicable to the customer.

The examiner relies on the following references:

Benyacar et al. (Benyacar)	5,003,584	Mar. 26, 1991
Jagadish et al. (Jagadish)	5,915,006	June 22, 1999
		(filed May 01, 1997)

The following rejections are on appeal before us:

1. Claims 1, 10 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Benyacar.

2. Claims 1-4, 6-14 and 16-19 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Jagadish.

3. Claims 5 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jagadish.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon supports each of the examiner's rejections of the claims on appeal. Accordingly, we affirm.

We consider first the examiner's rejection of claims 1, 10 and 11 under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Benyacar. These claims stand or fall together as a single group [brief, page 7], and we will consider claim 1 to be the representative claim for this group. The rejection requires that we consider the rules that follow.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,

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1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

With respect to representative, independent claim 1, the examiner finds that Benyacar discloses the claimed invention except that Benyacar does not teach accumulating the data in a plurality of predetermined target accumulators. The examiner, finds, however, that the operation disclosed by Benyacar inherently meets the claimed predetermined target accumulators [answer, page 3].

Appellants argue that the meaning given to "rule-based accumulation engine" and "rule-based discount engine" by those of ordinary skill in the art is a non-application specific, configurable system that processes input data to produce output data where the processing is dictated by a set of configurable rules such as if-then statements. Appellants argue that Benyacar does not teach the rule-based engines of claim 1. Appellants also argue that the examiner's use of inherency is improper because Benyacar does not necessarily perform the claimed method [brief, pages 7-9].

The examiner responds that there is no clear definition of "rule-based accumulation engine" or "rule-based discount engine" in the disclosure. Accordingly, the examiner asserts that it is proper to give these terms their broadest reasonable interpretation. The examiner interprets these terms to be met by

any processor which uses rules to accumulate data or to process data for discounts. The examiner notes that this definition appears to be consistent with the prior art. The examiner finds that Benyacar meets these definitions [answer, pages 5-8].

Appellants respond by disagreeing with the definitions of the terms "rule-based accumulation engine" and "rule-based discount engine" set forth by the examiner. Appellants insist that these terms must be interpreted in light of the entire specification. Appellants argue that the claims should not be interpreted in such a manner that they would read on the admitted prior art [reply brief].

We will sustain the examiner's rejection of claims 1, 10 and 11 as anticipated by, or in the alternative, as unpatentable over Benyacar. We agree with the examiner that Benyacar fully meets the claimed invention when the terms "rule-based accumulation engine" and "rule-based discount engine" are interpreted to mean any processor which uses various rules to accumulate data and various rules to discount data. The processor of Benyacar produces a billing record that clearly has rules for accumulating data and rules for determining the discounts which should be assigned to the accumulated data. The data in Benyacar is clearly accumulated in predetermined target

accumulators associated with each billing rule. We find that Benyacar teaches the method recited in claim 1, and the only question is whether Benyacar teaches the claimed "rule-based accumulation engine" and the "rule-based discount engine." As noted by the examiner, claims are given their broadest reasonable interpretation during examination. This rule exists because an applicant has the right during examination to amend the claims so that they clearly cover what the applicant intends to cover. The examiner's interpretation of the claims is consistent with this rule, and the examiner has properly determined the scope of the appealed claims. We note that appellants' specification offers no specific definition for these terms, and the specification simply indicates that at least one rule is established for processing a record. The processing in Benyacar clearly uses at least rule for processing a record. Appellants' argument that the claims should not be interpreted to read on the admitted prior art is without merit. The claims should be drafted so that they do not read on the prior art.

We now consider the examiner's rejection of claims 1-4, 6-14 and 16-19 under 35 U.S.C. § 102(e) as being anticipated by Jagadish. These claims stand or fall together as a single group except that claims 6 and 16 stand or fall together as a second group [brief, page 7].

With respect to representative, independent claim 1, the examiner has indicated how he reads the claimed invention on the disclosure of Jagadish [answer, page 4]. After noting what is disclosed by Jagadish, appellants' only argument is that the claims recite specific features for managing information and rendering discounts in a billing system that are not described or suggested by Jagadish [brief, page 10]. There is no specific rebuttal to any of the findings made by the examiner.

We will sustain the examiner's rejection of claims 1-4, 7-14 and 17-19 based on Jagadish. Appellants' response in the brief completely fails to provide a rebuttal to the rejection. To the extent that appellants are relying on the definitions of "rule-based accumulation engine" and "rule-based discount engine," these arguments fails for the reasons discussed above with respect to the rejection based on Benyacar.

With respect to separately argued claims 6 and 16, the examiner has indicated how he reads representative claim 6 on the disclosure of Jagadish [answer, page 4]. Appellants argue that the portion of Jagadish relied on by the examiner fails to describe or suggest the claimed assigning of a logical name to a source field [brief, page 10]. The examiner responds that the number of a telephone line constitutes a logical name, and passing it to the billing analysis system reads on its assignment to a source field [answer, page 5].

We will sustain the examiner's rejection of claims 6 and 16. We agree with the examiner that the assignment of a telephone number to a billing account as disclosed in Jagadish meets the claimed assignment of a logical name to a source field. Appellants' argument in the brief is nothing more than a conclusion and offers no specifics which would support a rebuttal of the examiner's findings.

We now consider the examiner's rejection of claims 5 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Jagadish. These claims stand or fall together as a single group [brief, page 7].

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The examiner has indicated how he finds the invention of representative claim 5 to be obvious over the teachings of Jagadish [answer, page 4]. Appellants' only argument with respect to claims 5 and 15 is that these claims are dependent claims and are believed to be patentable [brief, page 10].

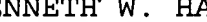
We will sustain the examiner's rejection of claims 5 and 15. Since we find that the examiner has established a prima facie case of the obviousness of claims 5 and 15, and since appellants have offered no arguments to rebut the rejection, we find claims 5 and 15 to be unpatentable for the same reasons discussed above.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-19 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


KENNETH W. HAIRSTON
Administrative Patent Judge

Jerry Smith
JERRY SMITH
Administrative Patent Judge

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